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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/995,992 | 11/16/2001 | Atchara Chaiyawat | 60SI01996 | 2195 |

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EXAMINER

HOWARD, SHARON LEE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1615

DATE MAILED: 08/21/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,992

Applicant(s)

CHAIYAWAT ET AL.

Examiner

Sharon L. Howard

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Examiner acknowledges receipt of one month extension of time and request for reconsideration filed on 6/13/03.

Claims 1-19 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3,5,7 remain rejected under 35 U.S.C. 102(b) as being anticipated by the WO 99/22696 document.

The WO '696 reference discloses a makeup composition comprising a silicone gel, wherein the gel comprises an organopolysiloxane elastomer dispersed in a silicone-compatible vehicle and a silicone oil base. The document discloses that the gel is formed from hydrosilation products (page 4, lines 3-34), of an organopolysiloxane having vinyl or allyl groups bonded to at least one terminal silicon atom, and organohydrogenpolysiloxane (page 5, lines 1-5). The silicone oil base may contain oils other than silicone oil, esters, petrolatum and fatty alcohols (page 7, lines 8-34), a colored material (e.g. iron oxides, titanium dioxide and ultramarines, D&C or FD&C pigments, lakes and blends thereof (page 9, lines 8-25). The reference also discloses using film forming agents which can confer transfer-resistance to the makeup product

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(page 9, lines 29-32). The reference discloses that the gel composition is also known to be formulated in lipsticks, powders, blushes, mascara, foundations, eyeliners, eyeshadows (page 6, lines 14-21).

The reference meets the limitations of the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/22696 document in combination with Kilgour et al. (USP 5,760,116).

The WO' reference is discussed above.

Although the WO' reference generically discloses that the gel is formed from hydrosilation products, the document does not teach a particular gel formation.

However, Kilgour teaches cosmetic compositions comprising a silicone gel consisting of a gel which is formed by the hydrosilylation product of a linear alkenyl stopped polyorganosiloxane and a resin (col.5, lines 35-67, bridging col.6, lines 1-51). Kilgour also discloses a process for dispersing a silicone gel comprising a hydrosilylating a linear alkenyl stopped polyorganosiloxane (col.4, lines 36-67) with a resin, in the presence of a first silicone thereby forming a gel and mixing said gel with a second silicone (col.5, lines 7-31). Kilgour teaches that the compositions are known to

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be useful in color cosmetics such as lipsticks, blushes, foundations, makeup and mascara (col.8, lines 48-58).

Both references teach cosmetic compositions containing a silicone gel. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. **See In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).** Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of the WO' document and Kilgour. One having ordinary skill in the art would have been motivated to prepare a third composition by including the particular gel into the composition of the WO' document, because the third composition can be used for the same purpose forming a gel from a silicone.

The expected result would be a cosmetic composition comprising a silicone gel, a colored material or pigments and a dispersing vehicle.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Response to Arguments

Applicant's arguments filed 6/13/03 have been fully considered but they are not persuasive. Applicant argues that applicants do not utilize a film forming agent to confer transfer resistance. Applicant argues that there is no suggestion by the art cited that

would render obvious the removal of the prior art film forming agent taught in WO 99/22696 and still arrive at Applicants' transfer resistant cosmetic composition.

In response to applicant's argument that there is no motivation to use a film forming agent as taught by the WO '696 reference. However, there is a motivation to use a film forming agent as taught by the WO '696 reference, because the reference teaches a makeup composition comprising a silicone gel consisting of an organopolysiloxane elastomer dispersed in a silicone-compatible vehicle and a silicone base (see page 4, lines 3-34 and page 5, lines 1-5). The reference also teaches a colored material consisting of iron oxides, ultramarines and titanium dioxide, D&C or FD&C pigments, lakes and blends thereof, including other ingredients such as film-forming agents (see page 9, lines 29-32) which are known in the art for exhibiting transfer resistant properties to be desired.

In conclusion, the "comprising" language in claim 1 permits the presence of the film forming agents and does not preclude the presence of the film forming agents, active or inactive even in major amounts. *See Moleculon Research Corp v CBS, Inc 229 USPQ 805; In re Baxter 210USPQ 795, 803.*

Therefore the claims are anticipated by the (WO '696) reference and the (WO '696) reference make applicant's invention obvious.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Howard whose telephone number is (703) 308-4359. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-3121 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Sharon Howard
August 14, 2003



CARLOS AZPURU
PRIMARY EXAMINER
GROUP 1500